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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,027	06/19/2003	Marc Odrich	018158-011140US	5696
20350	7590	02/23/2006	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			SHAY, DAVID M	
			ART UNIT	PAPER NUMBER
			3735	

DATE MAILED: 02/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.		Applicant(s)	
	10/600,027		ODRICH ET AL.	
	Examiner		Art Unit	
	david shay		3735	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on October 26, 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Applicant argues that the originally filed claims are part of the specification and therefore the application did have an adequate written description. The fact that the material of the claims may or may not be contained per se in the originally filed specification is not the issue. Claims 1-9 recite "...adjusting an ablation cut profile of the multifocal ablation shape in response to the size of the pupil..." The pertinent part of paragraph [0022] referred to in the previous office action being "The invention provides for adjusting the ablation to compensate for factors effecting the final geometry of the healed cornea." (emphasis added). Applicant has not adequately taught how to adjust the geometry of the cornea after it is healed at a time before it is incised. The variability of the healing response is sufficiently different from individual to individual that applicant must provide factors that will determine the precise way the cornea will heal for the various classes of individual corneas, if a step of "adjusting..." wherein the adjusting is predicated on the "final geometry of the healed cornea". The examiner has included an article by Sher et al from chapter 6 Corneal Laser Surgery, Mosby, St. Louis, MO, 1995, entitled "Correction of high Myopia with the Excimer Laser: VISX 2015, VISX 2020; and the Summit Experience" showing the extreme variability of healing of the cornea. Applicant has provided no algorithm to model this behavior, and thus the claims are inadequately supported by the originally filed disclosure.

With regard to the art rejections, applicant argues that Frey et al only teach altering the size of the ablation zone of a single correction, while Largent does not teach altering the size of the ablation zone due to the change in pupil size. The examiner notes that *prima facie* obviousness is evaluated on the basis of what the combined references would teach one having ordinary skill in the art at the time of the invention. The examiner notes that one having ordinary

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skill in the art would be an ophthalmologist who is at least familiar with the basics of providing multifocal correction to patients afflicted with presbyopia. Those familiar with these basics will understand that both corrections are provided for a reason and that *both* corrections must be usefully available to the patient in order to produce a useful correction e.g. in the method of Largent. The same knowledge that would allow the ophthalmologist to determine the relative ratios of the two corrections to begin with, would allow that same ophthalmologist to produce an appropriate ratio of the relative areas of the two corrections in view of an alteration in size of the optical zone based on pupil size, as taught by Frey et al. Just as if the ophthalmologist were adjusting a prescription for bifocals from one size lens to a second, different sized lens in a pair of conventional spectacles. Thus these arguments are not convincing.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The originally filed disclosure does not teach how to preoperatively determine the factors which are disclosed as the things beings adjusted for, as all these are set forth appear determinable only after the ablation has already taken place (see the originally filed disclosure, paragraph [0022], bridging pages 5 and 6).

Claims 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frey in combination with Largent. Frey teaches a laser surgical system including a laser and a processor

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and scaling the ablation to the pupil size (see column 1, lines 5-10 and column 2, lines 46-55).

Largent teaches designing a corneal ablation to mitigate presbyopia. It would have been obvious to the artisan of ordinary skill to employ the device of Frey on a subject with presbyopia, since this condition is correctable with laser sculpture as taught by Largent, or to employ the pupil scaling device of Frey in the presbyopia treating system of Largent, since this would reduce the halo effect and improve night vision, as taught by Frey, thus producing a device such as claimed.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 10-15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6,280,435. Although the conflicting claims are not identical, they are not patentably distinct from each other because performing the method would require a device as claimed.

Claims 1-15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-35 of U.S. Patent No. 6,663,619. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent anticipate the claims of the application. Accordingly, instant application claims are not patentably distinct from the patent application claims. Regarding the method

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claims, the patent claims require elements A, B, C, and D while the application claims only requires elements A, B, and C. Thus it is apparent that the more specific patent claims encompass the application claims. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer; with regard to the apparatus claims, performing the method would require a device as claimed.

Applicant's arguments filed October 26, 2005 have been fully considered but they are not persuasive. The arguments are not persuasive for the reasons set forth above.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to david shay whose telephone number is (571) 272-4773. The examiner can normally be reached on Tuesday through Friday from 6:30 a.m. to 5:00 p.m.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco, can be reached on Monday through Friday. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DAVID M. SHAY
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